REMARKS

Claims 1-48 are pending in the present application. Reconsideration of the claims in light of the following arguments is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

Claims 1-11, 22, 25-30, 32-35, and 46 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maddalozzo, Jr. et al (6,012,093) and Gupta et al. (6,487,538), hereinafter Maddalozzo and Gupta respectively. This rejection is respectfully traversed.

Representative claim 1 reads,

> 1. (Previously presented) A method in a data processing system for managing a history for a browser, the method comprising:
> recording a history for a browser; and
> selectively exporting a portion of the history for use by another program or computer system.

Regarding this claim, the rejection states,

> As per independent claim 1, Maddalozzo teaches a method in a data processing system for managing a history for a browser, the method comprising: recording a history for a browser (Abstract), but does not specifically teach selectively exporting a portion of the history for use by another program or computer system. However Gupta teaches selectively exporting a portion of the history for use by another program or computer system (col. 6, lines 31-45; col. 9, lines 52). Therefore it would have been obvious to one of ordinary skill in the art of the time of the invention to include exporting of information as taught by Gupta in the invention of Maddalozzo because it is desirable for advertisements to target specific audiences and persons that may be interested in the specific good and service being advertised.

The Federal Circuit has had the following to say regarding art cited in a patent rejection,

> In order to rely on a reference as a basis for rejection, the reference must be either in the applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, ___, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313,

315 (Fed. Cir. 1986).

> It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443, ___, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979).

As claim 1 indicates, this application is directed to "a method, apparatus, and computer implemented instructions for managing history logs generated by a browser"[1]. It is submitted that Gupta would not be considered as analogous art by one of ordinary skill in the art and thus would not be considered by the Federal Circuit as appropriate art to cite in this rejection.

In support of this assertion, it is noted that Gupta itself asserts that it is directed to,

> A method and apparatus for local advertising. Internet Service Providers (ISPs) or proxies owned by an ISP insert advertisements transmitted from a web host to a client. The advertisement may be stored in the proxy's cache or may be retrieved from a web server for an advertiser. By providing the ISP with the ability to insert the advertisement, advertisements appear on small web sites that do not normally attract advertisers. Additionally, due to the number of advertisements placed by an ISP, small advertisers may have their advertisement appear in connection with frequently used web sites.[2]

Gupta is directed to managing advertising on the Internet, not to managing history logs or other aspects of a browser. Gupta addresses the problem of providing advertisers the ability to target specific audiences. Gupta does this by enabling Internet Service Providers (ISPs) to insert advertising into pages they are transmitting for a web host. In contrast, the ability to target advertising is not a skill that would be sought by one trying to manage history logs, as are Maddalozzo and the present invention.

Why is the question of non-analogous art important, if Gupta reputedly shows part of the invention? The answer is simply that the law does not require that an inventor

---

[1] Current application, page 1, lines 11-13
[2] Abstract of Gupta

be omnipotent or well read in all areas of knowledge. Patent law does expect that an inventor will be cognizant of any work in their practice area, but it cannot and does not expect the inventor to be knowledgeable in all areas. Thus, when dealing with an area such as browser histories, an inventor is expected to be aware of the work done by others that concern browser histories or other related subjects, but it does not expect the inventor to read extensively in the area of advertising. Thus, if an inventor dealing with the problem of managing history logs kept by a browser cannot reasonably expect a patent to be related to this area, the inventor would not be expected to have known the information contained in the patent. In this instance, it is submitted that the subject matter is not one that the inventor could reasonably be expected to be aware of; thus, it is thus submitted that Gupta is non-analogous art and should not be considered in the current rejection, regardless of whatever it might teach.

Furthermore, it is asserted that even if Gupta is considered, which applicants have argued against, this patent does not teach a portion of the claimed invention. The claim recites, "recording a history for a browser; and selectively exporting a portion of the history for use by another program or computer system". Gupta allegedly teaches "selectively exporting a portion of the history". However, Gupta is directed to a web server that captures user accesses and builds a profile of the user. The server cannot export information from a browser. It may gather information that the browser gives it; it may read cookies from other sites the browser has visited, etc., but the server is not in control of the browser and cannot export history for the browser.

The cited portions of Gupta state,

> The profile information may be utilized by the proxy to conduct targeted advertising or the information may be provided to a web host so that the web host may conduct targeted advertising. The profile information may also be utilized to associate a cost with certain demographic information. For example, if the profile information indicates that the user is interested in automobiles, a premium may be charged to an automobile advertiser. The profile information may be evaluated by the ISP for advertisement insertion. Alternatively, the profile information may be forwarded to an advertiser or advertising agency that evaluates and forwards back an advertisement for the proxy

> to transmit to the user. Thus, the profile and demographic information is utilized to precisely target advertisements to specific users.[3]
>
> A profile 304 for each client is maintained in a Client Identification & Classification System. Profile 304 contains all information regarding a particular client or user including information collected off-line such as the user's name, residence, phone number, occupation, alternate email address, etc. The information from the raw database 302 is transferred and organized in the profile 304. Profile 304 may then be merged with other information databases such as mailing lists, direct marketing lists and subscriptions, a user's credit history, and shopping club information (e.g., if the user is a member of a market's shopping club, the information from the shopping club's database may be merged through an agreement between Proxy 102 and the market). The profile may also be time sensitive and created in real time so that when a user executes a search on an internet search engine, the search text is stored in the profile immediately. Additionally, if the user is at a non-payment based public terminal (e.g., at a library), the profile may be limited to the user's recent history and information about the terminal and terminal location may be utilized. Further, if the user is at a payment-based public terminal, the client's address, credit card information, and recent history as the user browses the internet may be utilized.[4]

These portions of Gupta speak only of acting in the person of the server; they do not suggest that the browsers that use the server are exporting their histories to the browser. It is submitted that this is a clear distinction that can be ignored only by ignoring the clear meaning of the claims.

Therefore, it is asserted that the rejection of claims 1-11, 22, 25-30, 32-35, and 46 has been overcome.

Claims 12-18, 23, 36-42, and 47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maddalozzo and MS Internet Explorer. This rejection is respectfully traversed.

Representative claim 12 reads,

> 12. (Previously presented) A method in a data processing system for logging browsing activities for a browser, the method comprising:
> logging Web pages visited using the browser to form a log;
> presenting the log;

---

[3] Gupta, column 6, lines 32-45
[4] Gupta, column 9, line 53 - column 10, line 8

receiving a selection of a portion of the log; and
deleting said portion of said log in response to receiving the selection.

Regarding this claim, the rejection states,

> As per claim 12, Maddalozzo teaches a method in a data processing system for logging browsing activities for a browser, the method comprising:
> logging Web pages visited using the browser to form a log (col. 4, lines 6-9), presenting the log (col.4, lines 13-16), and receiving a selection of a portion of the log (col.4, lines 14), but does not specifically teach deleting said portion of said log in response to receiving the selection. However MS Internet Explorer teaches deleting said portion of said log in response to receiving the selection (figs. 1 and 2, item # 10 and 20). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include deleting of history files as taught by MS Internet Explorer in the invention of Maddalozzo in order for user to save memory space and manage the history files.

It is noted that the citation of MS Internet Explorer includes a page giving the version of Explorer as 6.0.2800.1106CO, which includes update versions SP1; Q810847; Q813951; Q828750; Q832894; Q831167; Q837009. Enclosed with this response is a copy of the page at www.microsoft.com/downloads from which one can download Service Pack 1 (SP1), which was part of the cited version of MS Internet Explorer. On this page, it is noted that SP1 was published on 9/9/2002 (see item A) and "includes a full installation of the Web browser" (see item B). It is therefore submitted that the cited program does not provide evidence of prior invention from applicant's filing date of June 18, 2001. Therefore, the rejection of claims 12-18, 23, 36-42, and 47 under 35 U.S.C. § 103 has been overcome.

Claims 19-21, 24, 43-45, and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maddalozzo and Straub et al. (6,216,141), hereinafter Straub. This rejection is respectfully traversed.

Representative claim 19 reads,

> 19. (Previously presented) A method in a data processing system for presenting a history of browser activities, the method comprising:
> logging Web pages received by a browser session to form a log; and
> in response to a request to display said log, sequentially displaying Web pages from the log.

Regarding this claim, the rejection states,

> As per Claim 19, Maddalozzo teaches a method in data processing system for presenting a history of browser activities, the method comprising: logging web pages received by a browser session to form a log (Figs. 3 and 4; col. 3, lines 13-20 and lines 37-45), but does not specifically teach in response to a request to display said log, sequentially displaying web pages for the log. However Straub teaches in response to a request to display said log, sequentially displaying web pages for the log (col. 9, lines 24-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include sequentially displaying of files as taught by Straub in the invention of Maddalozzo in order to provide an user with an automated navigation controls which the user can use to scan through a list of documents or files.

It is submitted that Straub, like Gupta, is not analogous to the present invention. Straub is directed to,

> A system and method for displaying a rich multimedia document in the same window as a desktop window. In one aspect of the invention a client computer connects to a computer network, such as the Internet, and retrieves a channel guide or list of content providers from which a user can select one or more content providers. The client computer retrieves a document associated with a content provider selected from the channel guide. The document is integrated into the desktop window on the client computer. The document received may be an HTML document including hyperlinks for allowing a user to jump to another document (e.g., folder, FTP site, other HTML documents, etc.) associated with the hyperlink.

Straub is providing a means for a user to have resources available on the desktop that can be viewed like any other documents that a user might have in a windows environment. However, Straub does not appear to be directed to managing histories on a browser, nor to a related field. As argued earlier with regard to Gupta, Straub is not related to the issue at hand and patent law does not expect the inventor to be cognizant of art outside of their area. Straub should therefore not be used in an obviousness rejection against these claims of the instant application. Therefore, the rejection of claims 19-21, 24, 43-45, and 48 under 35 U.S.C. § 103 has been overcome.

Claims 7 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maddalozzo and Bertis (6,243,093). This rejection is respectfully traversed.

Claims 7 and 31 are both dependent claims. It is submitted 5that because their independent claims have been shown to be allowable, these claims inherit the allowability of their parent claims. Therefore, the rejection of claims 7 and 31 under 35 U.S.C. § 103 has been overcome.

It is submitted that all rejections have been overcome.

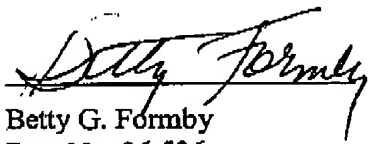
II. Conclusion

It is respectfully urged that the subject application is patentable over Maddalozzo, Gupta, MS Internet Explorer, Straub, and Bertis and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: Jan 10, 2005

Respectfully submitted,



Betty G. Formby
Reg. No. 36,536
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Agent for Applicants